

REMARKS

Summary Of The Office Action & Formalities

Claims 1-11 are all the claims pending in the application. Claims 3-8 are withdrawn from consideration pursuant to the Examiner's restriction requirement.

----- Applicant is submitting herewith a drawing correction for the approved change to Fig. 10. -----

Applicant thanks the Examiner for confirming that the certified copy of the priority document was received by the USPTO.

The Examiner has made the present Office Action final. However, in the first Office Action on the merits dated December 3, 2002, the Examiner only rejected the claims under 35 U.S.C. § 112, second paragraph. Accordingly, Applicant submits that the present Office Action was prematurely made final and kindly requests the Examiner to reconsider and withdraw its finality.

Applicant submits that the original claims were not so indefinite as to prevent the Examiner from substantively considering these claims on the merit in view of the prior art. Indeed, the Examiner apparently had sufficient understanding of the claims to issue a restriction requirement and maintain the restriction in response to Applicant's traversal. Furthermore, as set forth in the Manual Of Patent Examining Procedures ("MPEP"), the Examiner should guard against premature final rejections. A premature final rejection may result from failure to permit a full development of clear-cut issues. Or, again, if the Examiner waits until the final rejection before giving an adequate explanation of the application of the references against the claims, such final rejection may be premature. See MPEP at Section 706.07. Here, the Examiner waited

until the final rejection to present his first prior art rejection, which could and should have been made in the previous Office Action.

Claims 1,2, and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Diolot (U.S. Patent No. 3,524,374) in view of Keim (U.S. Patent No. 3,975,132).

Applicant traverses.

Claim Rejection- 35 U.S.C. § 103

In rejecting claims 1, 2, and 9-11, the Examiner states:

Diolot discloses a device with almost every structural limitation of the claimed invention but lacks both blades being movable and driven, and further lacks both blades sharing the same guide means. However, the Examiner takes Official notice that such blade support/drive configuration is old and well known in the [art] and provides various well known benefits including simple and efficient construction and operation. Keim discloses one example of an analogous press configuration disclosing a shared support/drive configuration. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a blade support/drive configuration on the device of Diolot for the well known benefits including those described above.

Office Action at page 3. Applicants respectfully disagree.

MPEP Section 2144.03 provides (with added emphasis):

The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art.

* * *

If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA

1942). If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

Applicant hereby traverses the Examiner's assertion that claimed blade support/drive configuration "is old and well known in the [art] and provides various well known benefits including simple and efficient construction and operation." The Examiner has pointed to a single reference, Keim, as allegedly providing evidence of this fact. However, Applicant maintains that the Examiner has not set forth a prima facie case of obviousness in view of Diolot and Keim

Section 2142 of the MPEP states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Federal Circuit has also reminded us that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, In Lee, USPQ2d 1430, 1433 (Fed. Cir. 2002), citing, e.g., In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

The Federal Circuit goes on to emphasize that the “need for specificity pervades this authority.” In re Lee at 1433 (emphasis added) (citing In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

Applicant respectfully submits that the current grounds of rejection do not satisfy the Federal Circuit’s rigorous standard for demonstrating that the claimed invention would have been obvious in view of the combination of Diolot and Keim.

Diolot and Keim each describes a guide for the cutting apparatus, wherein a common guide can be arranged as explained therein because the frame for supporting the cutting apparatus has a closed structure referred to the gate-type. This is because the cutting apparatus is not required to move in the width direction of the work piece and is stationary.

In the present invention, due to the function of welding machine, a movement in the widthwise direction must be made. Therefore, one of the frame must not be closed but must be the C-type open at one side.

In this case, one of the guides is required to be open because the frame must move in the plate width direction during welding and is closed when necessary, i.e., during cutting. In such case, the guide is required to have a different arrangement form the gate-type.

Thus, in the Diolot and Keim disclosures, the guide is not a completely detachable guide but a simple guide is used in common for clearance setting and for guiding.

In the present invention, on the other hand, one of the guides is in the upper section and, as a result of this, the guide can be made not to interfere with the plate during movement, thus realizing the detachable guide.

Moreover, the Examiner acknowledges that Diolot fails to disclose "both blades being movable and driven, and further lacks both blades sharing the same guide means." Applicant agrees. In fact, Diolot is specifically directed to a rapid-cutting guillotine having a stationary upper cutting blade as shown in Fig. 1. The emphasis placed on having a stationary blade pervades the specification and claims. Note the following disclosures:

As illustrated in FIGURE 1, the shearing machine comprises a frame 1 whose upper cross-member 2 serves as a support for the fixed blade 3. On the lateral uprights of the frame 1 there are fixed vertical sideways 4 and 4a in which the mobile support 5 of the lower blade 6 slides. This blade has its cutting portion in the form of a very open V with the opening directed upwardly toward the fixed blade 3. (Column 1, lines 46-53).

Figure 2 shows in detail a sectional view of one of the damping systems provided by the invention. On both ends of the rod 9, sliding through the guides 22 fixed to the frame 1, there is mounted a metallic part 15 . . . (Column 2, lines 1-4).

When the rod 9 on which the piston 8 is mounted carries out a movement to one side or the other by means of the force applied to the piston, the links 10 and 10a connected to the mobile blade carrier 5 effect a complete upward and downward movement cycle of the cutting blade 6 . . . (Column 2, lines 23-27).

The cutting operation lasts for only a very short fraction of a second; and during cutting, the strip is held firmly in position between the two blades, owing to the special wide-open V form of the mobile blade 6.

The end-of-travel impact of the piston 8 is damped by means of the damping device proposed and described hereinabove. (Column 2, lines 34-40).

The foregoing quotes demonstrate the importance of having a stationary blade and a dampened movable blade that cooperates with the stationary blade to carry out the cutting operation. The Examiner has not pointed to any disclosure in this reference or in Keim (which is not directed to a cutting machine) that would teach or suggest radically modifying the cutting machine of Diolot to include a movable upper blade and a common support guide.

The Examiner merely alleges that “such blade support/drive configuration . . . provides various well known benefits including simple and efficient construction and operation.” However, neither Diolot nor Keim provide support for this alleged motivation to modify the machine of Diolot. To the contrary, Diolot would teach away from making the upper blade movable, given the specific cooperation of the various parts of this machine described in its disclosure. Furthermore, Keim is directed to a press for molding sheet metal and is entirely silent about the Examiner’s stated advantages. Therefore, it would not have been obvious to one having ordinary skill in the art “to provide such a blade support/drive configuration on the device of Diolot for the well known benefits including those described above,” and the Examiner is kindly requested to reconsider and withdraw the rejection of claims 1, 2 and 9-11.

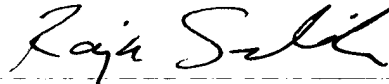
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

U.S. APPLICATION NO. 09/754,341
AMENDMENT UNDER 37 C.F.R. § 1.116

Q62470

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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